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| 09/894,501 | 06/28/2001 | Ernest W. Moody | MOODY 17 | 7452 |

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**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application Number: 09/894,501
Filing Date: June 28, 2001
Appellant(s): MOODY, ERNEST W.



John Edward Roethel
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 12 April 2004 appealing from the Office action mailed 12 January 2004.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is deficient. 37 CFR 41.37(c)(1)(v) requires the summary of claimed subject matter to include: (1) a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters and (2) for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. The brief is deficient because as written, it is unclear whether the payout is determined for the bonus game or for a combination of the bonus game and base game. The description leaves open the possibility that a player gets one award for the base game and another for the bonus. This is not the case. There is a single award that is determined by the base game. That award is paid after the sham bonus game. Furthermore, the Appellant states that regardless of how the player fares in the bonus game, the game continues until the player has won the amount determined in the base game. This is not part of the claims.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

2,102,532 Hoke 11-1936

Geddes, Slot Machines on Parade, Mead, 1980, pages 116 & 121

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Hoke (US Patent Number 2,102,532).

**Claim 1:** Hoke teaches a method of playing a gaming machine in which a bonus round includes an apparent game of skill (i.e., shooting the ball into the snake's mouth). The player makes a wager, which activates the gaming machine to cause a game of chance to occur – i.e., the slot reels spin. The machine then determines the outcome of the game of chance and, if the outcome awards the player a bonus round (i.e., if the player wins a payout), selects an amount of a bonus payout to be paid to the player during the bonus

round. The player then participates in an apparent game of skill at the end of which, the player receives the bonus payout. (Page 4, 11-23)

Geddes, which is made of record but not relied on for this rejection makes it plain that the bonus game (flipping the ball into the snake's mouth) is an illusion of skill game. According to Geddes (on page 116):

> "This form of skill was a complete sham and was used on the Mills HOKE SNAKE. When the snake said, "Feed The Snake," it meant to tap the little lever below it and try to flip the ball into the snake's mouth. This feat required the ability to steam a mirror using only your breath. Every time a winner occurred on the machine, the mechanism would come to a halt just before the payout was to occur and the player had to "Feed The Snake" to allow the player to finish its cycle."

**(10) Response to Argument**

Appellant argues that the difference between the instant invention and Hoke's invention is that Hoke discloses an actual game of skill and that a player has to win both the base game and the skill game in order to receive a payout. Appellant states that this is not the claimed invention. According to the Appellant, the claimed invention will pay even when the player loses the skill game.

This is not commensurate with the scope of the claims. Claim 1 states in pertinent part, "allowing the player to participate in the apparent game of skill or knowledge [sic] at the end of which the player receives the bonus payout." There is absolutely no mention of paying regardless of the outcome of the apparent game of skill or knowledge. A game that paid out

only when the player won the game of apparent skill or knowledge would anticipate the claim. So even if Appellant's description of Hoke was correct, and the evidence shows that it is not, then Hoke still anticipates the claimed invention.

Even if we look at Appellant's argued invention (as distinguished from the invention Appellant actually claimed), Hoke anticipates the invention. Appellant's argument is that Hoke teaches a game of actual skill. If Hoke's game is not an actual skill game, then Appellant's argument falls to the ground. But as Geddes points out, Hoke's skill game was "a complete sham". The level of skill involved is described as "the ability to steam a mirror using only your breath." In other words, no skill whatsoever was involved. If the player pushed the lever, the player won the bonus game. Therefore, there was no possibility that the player would lose the bonus game. There appears to be skill involved (i.e., it is an apparent skill game), but no actual skill is involved.

Hoke teaches a game in which there is a base game that determines a payout. Before the payout is made, the player must take part in a bonus game that appears to be a skill game, but actually requires no skill whatsoever. The player is then paid the amount determined by the base game. This is precisely the type of game Appellant argues and certainly meets Appellants (broader) claims.

Appellant quibbles over the use of "illusion of skill game" in the rejection. If a game is apparently a skill game, but no real skill is involved, then the game creates an illusion of skill. The phrase, "illusion of skill game" is normally used in the art to describe such a game, however, Examiner believes that the correlation between "apparent game of skill" and "illusion of skill game" is clear.

Appellant's attorney's statements concerning his many years of experience are not arguments. Furthermore it is well established that a secondary reference may be used to explain the teachings of a reference used in a rejection under 35 USC 102.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

CORBETT B. COBURN
PRIMARY EXAMINER

Corbett B. Coburn III, Primary Examiner

Conferees:

Robert Olszewski, SPE

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